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# FEE TRANSMITTAL

## For FY 2006

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** **(\$)** **500.00**

### Complete if Known

Application Number	09/774,682-Conf. #3648
Filing Date	February 1, 2001
First Named Inventor	Motoshi ASANO
Examiner Name	F. Poinvil
Art Unit	3628
Attorney Docket No.	SON-2024

### METHOD OF PAYMENT (check all that apply)

Check  Credit Card  Money Order  None  Other (please identify): \_\_\_\_\_

Deposit Account Deposit Account Number: 18-0013 Deposit Account Name: Rader, Fishman & Grauer PLLC

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### FEE CALCULATION

#### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

<u>Application Type</u>	<u>FILING FEES</u>		<u>SEARCH FEES</u>		<u>EXAMINATION FEES</u>		<u>Fees Paid (\$)</u>
	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

#### 2. EXCESS CLAIM FEES

##### Fee Description

Each claim over 20 (including Reissues)

<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>
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50 25

Each independent claim over 3 (including Reissues)

200 100

Multiple dependent claims

360 180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- =	x	=	

<u>Multiple Dependent Claims</u>	
<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>

HP = highest number of total claims paid for, if greater than 20.

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- =	x	=	


HP = highest number of independent claims paid for, if greater than 3.

#### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 100 =	/50	(round up to a whole number) x	=	

#### 4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal

500.00

<u>SUBMITTED BY</u>		<u>Registration No.</u> <u>(Attorney/Agent)</u>	<u>Telephone</u>
Signature	<i>RONALD P. KANANEN</i>	24,104	(202) 955-3750
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TRANSMITTAL OF APPEAL BRIEF		Docket No. SON-2024
In re Application of: Motoshi ASANO, et al.		
Application No. 09/774,682-Conf. #3648	Filing Date February 1, 2001	Examiner F. Poinvil
Invention: ELECTRONIC-MONEY SETTLEMENT METHOD AND INFORMATION PROCESSING APPARATUS THEREFOR		
<b><u>TO THE COMMISSIONER OF PATENTS:</u></b>		
Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>October 19, 2006</u>		
The fee for filing this Appeal Brief is <u>\$ 500.00</u>		
<input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity		
<input type="checkbox"/> A petition for extension of time is also enclosed.		
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<input checked="" type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>18-0013</u> . This sheet is submitted in duplicate.		
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<input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>18-0013</u> . This sheet is submitted in duplicate.		
 Ronald P. Kananen Attorney Reg. No. : 24,104 RADER, FISHMAN & GRAUER PLLC 1233 20th Street, N.W. Suite 501 Washington, DC 20036 (202) 955-3750		Dated: <u>March 1, 2007</u>



Docket No.: SON-2024  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Motoshi ASANO et al.

Confirmation No.: 3648

Application No.: 09/774,682

Art Unit: 3628

Filed: February 1, 2001

Examiner: F. Poinvil

For: ELECTRONIC-MONEY SETTLEMENT  
METHOD AND INFORMATION  
PROCESSING APPARATUS THEREFOR

**APPELLANT'S BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is an Appeal Brief under 37 C.F.R. §41.37 appealing the final decision of the Examiner dated June 19, 2006. Each of the topics required by 37 C.F.R. §41.37 is presented herewith and is labeled appropriately. This brief is in furtherance of the Final Office Action on June 19, 2006.

A Notice of Appeal was filed in this case on October 19, 2006, along with a Request for Panel Review and a *one-month* extension.

The Notice of Panel Decision From Pre-Appeal Brief Review mailed on February 1, 2007 ("the Decision) indicates that claims 1, 3-4 and 9-23 remain rejected.

The Decision further indicates that the extendable time period for the filing of the Appellant's Brief will be reset to be one month from the mailing of the Decision. Accordingly, the filing of the Appellant's Brief is timely.

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## **I. REAL PARTY IN INTEREST**

Sony Corporation of Tokyo, Japan ("Sony") is the real party in interest of the present application. An assignment of all rights in the present application to Sony was executed by the inventor and recorded by the U.S. Patent and Trademark Office at **reel 011767, frame 0481**.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

## **III. STATUS OF CLAIMS**

Within the Final Office Action of June 19, 2006:

Paragraph 2 of the Final Office Action includes a rejection of claims 1, 3, 4, 9-23 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka).

Paragraph 3 of the Final Office Action includes a rejection of claims 9-23 under 35 U.S.C. 102 as being anticipated by Nonaka.

Thus, the status of the claims is as follows:

Claim 1: (Rejected)

Claim 2: (Canceled)

Claims 3-4: (Rejected)

**Claims 5-8: (Canceled)**

**Claims 9-23: (Rejected)**

No claims are indicated within the Final Office Action to contain allowable subject matter.

Accordingly, Appellant hereby appeals the final rejection of claims 1, 3-4 and 9-23 which are presented in the Claims Appendix.

#### **IV. STATUS OF AMENDMENTS**

Subsequent to the final rejection of June 19, 2006, no amendment After Final Action has been filed.

#### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The following description is provided for illustrative purposes and is not intended to limit the scope of the invention.

The present invention relates to information processing systems and information processing apparatuses. In particular, the present invention can be applied to an electronic money system using portable information devices. According to the present invention, when an amount of electronic money deposited in an information processing apparatus is insufficient for a payment amount, by loaning money up to a predetermined limit to the user of the information processing apparatus and recording the amount of the loan in the information processing apparatus and a management center, the user can use electronic money even if a small amount of electronic money is deposited in the information processing apparatus.

**Claims 1, 3-4 stand or fall together** - Claims 3-4 are dependent upon claim 1. Claim 1 is drawn to an electronic-money settlement method comprising the steps of:

recording, in a portable electronic device (5) and a management center (3), information on a deposited amount of money, said information being stored in said portable electronic device (5) in the form of electronic money representing a monetary value (Specification page 9, line 18 to page 10, line 8, page 14, lines 12-18); and

recording, in said portable electronic device (5) and said management center (3), information on a loan made to the user of said portable electronic device (5) up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said portable electronic device (5) (Specification page 24, line 25 to page 25, line 12),

wherein said management center (3) calculates interest on the loan at a predetermined frequency in step SP25 (Specification Figure 5, page 14, lines 19-23, page 15, lines 14-17), and uses the calculation result to update said information on the loan in step SP26 (Specification Figure 5, page 15, lines 14-17).

**Claims 9-16 stand or fall together** - Claims 10-16 are dependent upon claim 9. Claim 9 is drawn to an electronic-money settlement method comprising the steps of:

loading electronic money from a portable electronic device (5) into an information processing apparatus, said electronic money having a monetary value (Specification page 24, line 25 to page 25, line 12);

establishing a loan when a payment amount exceeds said monetary value of said electronic money, said payment amount being a purchase price of a commodity (Specification page 24, line 25 to page 25, line 12); and

recording said loan in said portable electronic device (5) (Specification Figure 5, page 14, lines 19-23, page 15, lines 14-17).

**Claims 17-23 stand or fall together** - Claims 18-23 are dependent upon claim 17.

Claim 17 is drawn to an electronic-money settlement apparatus comprising:

information processing means (3, 6, 8, 10) for establishing a loan when a payment amount exceeds a monetary value of electronic money, said payment amount being a purchase price of a commodity (Specification page 24, line 25 to page 25, line 12);

means (6, 8, 10) for loading said electronic money from a portable electronic device (5) to said information processing means, said electronic money having said monetary value (Specification page 24, line 25 to page 25, line 12); and

means (6, 8, 10) for recording said loan in said portable electronic device (5) (Specification Figure 5, page 14, lines 19-23, page 15, lines 14-17).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The issues presented for consideration in this appeal are as follows:

Whether the Examiner erred in rejecting claims 1, 3, 4, 9-23 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka).

Whether the Examiner erred in rejecting claims 9-23 under 35 U.S.C. 102 as being anticipated by Nonaka.

These issues will be discussed hereinbelow.

## VII. ARGUMENT

In the Office Action of June 19, 2006:

The Examiner erred in rejecting claims 1, 3, 4, 9-23 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka).

The Examiner erred in rejecting claims 9-23 under 35 U.S.C. 102 as being anticipated by Nonaka.

For at least the following reasons, Appellant submits that this rejection is both technically and legally unsound and should therefore be reversed.

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below.

### *The Final Office Action lacks clarity*

Paragraph 2 of the Final Office Action includes a rejection of claims 9-23 under 35 U.S.C. 103(a) as being unpatentable over Nonaka.

Paragraph 3 of the Final Office Action includes a rejection of claims 9-23 under 35 U.S.C. 102 as being anticipated by Nonaka.

According, a rejection in paragraph 3 of claims 9-23 under 35 U.S.C. 102 as being anticipated by Nonaka is inconsistent with other actions taken by the Examiner within paragraph 2 of the Final Office Action.

The Advisory Action mailed on November 21, 2006 indicates the presence of a “typographical error” within the Final Office Action.

However, the explanation provided within the Advisory Action only raises a question as whether or not the rejection found within paragraph 2 of the Final Office Action is intended to be under 35 U.S.C. 102 or 35 U.S.C. 103 while also raising a question as whether or not the rejection found within paragraph 3 of the Final Office Action is intended to be under 35 U.S.C. 102 or 35 U.S.C. 103.

In this regard, the Office record for the above-identified application remains unclear. See M.P.E.P. §707.07(d).

**The Examiner erred in rejecting claims 1, 3, 4, 9-23 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka).**

**The Examiner erred in rejecting claims 9-23 under 35 U.S.C. 102 as being anticipated by Nonaka.**

These rejections are traversed at least for the following reasons.

**Claims 1, 3-4 stand or fall together** - Nonaka arguably teaches an electronic purse loan system wherein a repayment term storage may be provided in the personal information storage 34 in the center 3 (Nonaka at page 19, line 23 to page 20, line 5).

Within claim 1, information on a loan is recorded in both the portable electronic device (5) and the management center (3).

However, Nonaka fails to disclose, teach or suggest information on a loan is recorded in both the IC Card 1 and the center 3 of Nonaka.

- *Thus, Nonaka fails to disclose, teach or suggest recording, in said portable electronic device (5) and said management center (3), information on a loan made to the user of said portable electronic device (5) up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said portable electronic device (5).*

The Final Office Action contends that Figure 2a and 2b and 5 and 10 of Nonaka show the format of the data storage in the IC (Final Office Action at pages 2-3).

In response, Figure 2a and 2b and 5 and 10 of Nonaka fail to show the format of the data storage in the IC. Instead, Nonaka arguably teaches the presence of the personal information storage 34 in the center 3 (Nonaka at Figure 1, page 19, line 23 to page 20, line 5). Figures 2a and 2b and 5 and 10 of Nonaka depict reference number 34.

Also note that the IC card of Nonaka is described as reference number 1 (Nonaka at Figure 1, page 6, lines 22-23), which is shown within Figure 1 to be different than the personal information storage 34.

- *Thus, Nonaka fails to disclose, teach or suggest a management center that calculates interest on the loan at a predetermined frequency, and uses the calculation result to update the information on the loan.*

Nevertheless, the Final Office Action contends, without providing any supporting evidence, that Nonaka clearly teaches a management center providing a loan to a customer and recording the loan data at both the management center and a portable device of the user (Final Office Action at page 7).

In response to this contention, please note that Nonaka is silent regarding any interest calculation.

But as a gap-filler, the Final Office Action contend, *without providing any supporting evidence*, that charging interest on the loan amount is *inherent* in the system of Nonaka (Final Office Action at pages 7-8).

In response, this contention is conclusory and is not based upon any objective teaching found within Nonaka.

In particular, inherency requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

The Courts *have not* upheld arguments based on ‘inherent’ properties when there is no supporting teaching in the prior art” (emphasis added). *In re Dillon*, 13 USPQ2d 1337, 1348 (Fed. Cir. 1989). Instead, the Office Action must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV).

Rejections under 35 U.S.C. §103 are found within the Office Action. In this regard, “the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown” (emphasis added). *In re Spormann*, 150 USPQ 449, 452 (CCPA 1966).

A patentable invention, within the ambit of 35 U.S.C. §103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results *inherent* in their use. *In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969).

In addition, “such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection” (emphasis added). *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

**Claims 9-16 stand or fall together** - Nonaka fails to disclose, teach or suggest the means for recording the loan in the IC Card 1 of Nonaka.

- ***Thus, Nonaka fails to disclose, teach or suggest recording said loan in said portable electronic device.***

**Claims 17-23 stand or fall together** - Nonaka fails to disclose, teach or suggest the means for recording the loan in the IC Card 1 of Nonaka.

- ***Thus, Nonaka fails to disclose, teach or suggest means for recording said loan in said portable electronic device.***

## **Conclusion**

The claims are considered allowable for the same reasons discussed above, as well as for the additional features they recite.

Reversal of the Examiner’s decision is respectfully requested.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: March 1, 2007

Respectfully submitted,

By

Ronald P. Kananen

Registration No.: 24,104

Brian K. Dutton

Registration No.: 47,255

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Correspondence Customer Number: 23353

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Attorneys for Applicant

**CLAIMS APPENDIX**

1. (Previously presented) An electronic-money settlement method comprising the steps of:

recording, in a portable electronic device and a management center, information on a deposited amount of money, said information being stored in said portable electronic device in the form of electronic money representing a monetary value; and

recording, in said portable electronic device and said management center, information on a loan made to the user of said portable electronic device up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said portable electronic device,

wherein said management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan.

2. (Canceled)

3. (Original) An electronic-money settlement method according to Claim 1, wherein, when the loan exceeds a predetermined limit, said management center prohibits the use of electronic money by said portable electronic device.

4. (Original) An electronic-money settlement method according to Claim 1, wherein said management center updates a record of the remaining amount of the electronic money stored in said portable electronic device when being instructed to store electronic money in said portable

electronic device, and updates the remaining amount of the electronic money stored in said portable electronic device when being accessed by said portable electronic device so that priority is given to liquidation of the loan.

5-8. (Canceled)

9. (Previously presented) An electronic-money settlement method comprising the steps of:

loading electronic money from a portable electronic device into an information processing apparatus, said electronic money having a monetary value;

establishing a loan when a payment amount exceeds said monetary value of said electronic money, said payment amount being a purchase price of a commodity; and

recording said loan in said portable electronic device.

10. (Previously presented) An electronic-money settlement method according to Claim 9, wherein prior to the step of loading said electronic money, the method further includes the step of:

depositing said electronic money into said portable electronic device.

11. (Previously presented) An electronic-money settlement method according to Claim 9, further comprising the steps of:

adding said loan to said monetary value, the sum being a balance;

subtracting said payment amount from said balance, the difference being a remaining amount; and

updating said monetary value of said electronic money within portable electronic device with said remaining amount.

12. (Previously presented) An electronic-money settlement method according to Claim 11, further comprising the step of:

repaying said loan recorded in said portable electronic device prior to increasing said monetary value of said electronic money.

13. (Previously presented) An electronic-money settlement method according to Claim 9, further comprising the steps of:

calculating interest on said loan at a predetermined frequency, and

using said interest to update an amount of said loan.

14. (Previously presented) An electronic-money settlement method according to Claim 9, further comprising the step of:

recording in said portable electronic device a history of use of said portable electronic device a history.

15. (Previously presented) An electronic-money settlement method according to Claim 9, further comprising the step of:

prohibiting use of said electronic money by said portable electronic device when said loan exceeds a predetermined limit.

16. (Previously presented) An electronic-money settlement method according to Claim 9, the step of loading said electronic money includes the step of:

inducing power into said portable electronic device.

17. (Previously presented) An electronic-money settlement apparatus comprising:

information processing means for establishing a loan when a payment amount exceeds a monetary value of electronic money, said payment amount being a purchase price of a commodity;

means for loading said electronic money from a portable electronic device to said information processing means, said electronic money having said monetary value; and

means for recording said loan in said portable electronic device.

18. (Previously presented) An electronic-money settlement apparatus according to Claim 17, wherein said portable electronic device is a non-contact memory card having an identification code, power being induced within said non-contact memory card.

19. (Previously presented) An electronic-money settlement apparatus according to Claim 17, wherein said information processing means subtracts said payment amount from said balance, the difference being a remaining amount,

    said information processing means updating said monetary value of said electronic money within portable electronic device with said remaining amount.

20. (Previously presented) An electronic-money settlement apparatus according to Claim 17, further comprising:

    means for depositing said electronic money into said portable electronic device.

21. (Previously presented) An electronic-money settlement apparatus according to Claim 17, further comprising:

    means for calculating interest on said loan at a predetermined frequency, said interest being used to update an amount of said loan.

22. (Previously presented) An electronic-money settlement apparatus according to Claim 17, further comprising:

    means for prohibiting use of said electronic money by said portable electronic device when said loan exceeds a predetermined limit.

23. (Previously presented) An electronic-money settlement apparatus according to Claim 17, further comprising:

means for recording in said portable electronic device a history of use of said portable electronic device a history.

**EVIDENCE APPENDIX**

There is no other evidence which will directly affect or have a bearing on the Board's decision in this appeal.

**RELATED PROCEEDINGS APPENDIX**

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.